

## REMARKS

### I. Status of the Claims

Claims 1-29 remain pending in this application. Claim 29 has been amended to recite that when Y in formula (II) is  $\text{NR}_7$ , where  $\text{R}_7$  is hydrogen, n is 0 and m is 1, then  $\text{R}_2$  is not hydrogen. Support for the added language can be found in the claims and specification as originally filed. Applicants are now simply claiming less than they originally disclosed. Accordingly, this amendment presents no issue of new matter.

Further, Applicants respectfully submit that *In re Johnson*, 194 U.S.P.Q. 187 (C.C.P.A. 1977) provides legal precedent for the addition of this proviso. The C.C.P.A. held that where Applicants disclose a genus and numerous species, it is proper for Applicants to define the bounds of his claims by claiming that genus minus some of those species. *Id.* at 196. To argue otherwise “let[s] form triumph over substance, substantially eliminating the right of an applicant to retreat to an otherwise patentable species merely because he erroneously thought he was the first to make the genus when filed.” *Id.* Since Applicants are merely claiming less than they originally disclosed in their specification, according to M.P.E.P. § 2173.05(i), the amendment has Section 112 support and raises no new matter concerns.

The Examiner has indicated that claims 1-28 are allowable.

### II. Japanese Office Action

The Examiner has asked Applicants to provide a copy of the First Office Action issued in Japanese Patent Application No. 2004-071608, recited in Applicants' Form SB/08, because this document was “unavailable” to him. Accordingly, Applicants

submit as an enclosure to this Amendment another copy of this document for the Examiner's consideration.

### **III. Rejection under 35 U.S.C. §102(b)**

The Office rejects claims 29 under 35 U.S.C. § 102(b) as being anticipated by Yokoyama et al., U.S. Patent No. 4,734,418 ("Yokoyama"). Office Action at page 2. According to the Office, Yokoyama teaches a compound 3,5-dinitro-2-piperazinopyridine having a formula identical to Applicants' claimed formula (II), wherein  $R_2$  is chosen from a hydrogen atom,  $n$  is 0,  $m$  is 1 and  $Y$  is chosen from a radical  $NR_7$  in which  $R_7$  is chosen from a hydrogen. *Id.* Although Applicant disagrees with this rejection, in order to advance prosecution, Applicant has amended claim 29. In view of the amendment, the rejection is now moot and should be withdrawn.

### **IV. Conclusion**

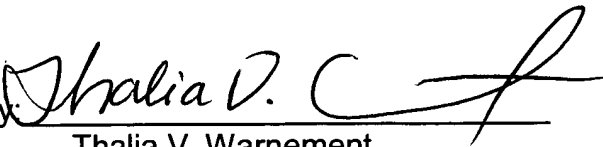
In view of the foregoing amendment and remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

**Dated: August 31, 2006**

By:   
Thalia V. Warnement  
Reg. No. 39,064

Enclosures: Decision of Rejection for Japanese Application No. 2004-071608  
English translation of Decision of Rejection for Japanese Application No.  
2004-071608

## 拒絶理由通知書

特許出願の番号

特願2004-071608

起案日

平成17年 5月27日

特許庁審査官

岩下 直人

9841 4C00

特許出願人代理人

志賀 正武(外 4名) 様

適用条文

第29条第2項

この出願は、次の理由によって拒絶をすべきものである。これについて意見があれば、この通知書の発送の日から3か月以内に意見書を提出して下さい。

## 理 由

この出願の下記の請求項に係る発明は、その出願前日本国内又は外国において頒布された下記Aの刊行物に記載された発明又は電気通信回線を通じて公衆に利用可能となった発明に基いて、その出願前にその発明の属する技術の分野における通常の知識を有する者が容易に発明をすることができたものであるから、特許法第29条第2項の規定により特許を受けることができない。

記 (引用文献等についてはAを参照)

A

1. 特開昭61-218512号公報
2. 特開昭58-034857号公報
3. 特開昭49-050144号公報
4. 特開平04-120013号公報
5. 国際公開第01/78668号パンフレット

- ・請求項 1-28
- ・引用文献等 A1-A5
- ・備考

A2-A5に代表されるように、染毛剤のカップラーとして使用する化合物であって、ピリジン骨格を有する化合物において、3位と5位をアミノ基とすることは周知であることに鑑みると、A1に記載されるような染毛剤のカップラーとして使用するところのピリジン骨格を有する化合物において3位と5位をアミノ基としてみることは当業者が容易になし得るものである。

請求項に係る発明とすることにより当業者の予測を超えるような格別に顕著な効果が生じるものとも解されない。

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先行技術文献調査結果の記録

- ・調査した分野     I P C 第 7 版   A 6 1 K 7 / 0 0  
                         D B 名

- ・先行技術文献

この先行技術文献調査結果の記録は、拒絶理由を構成するものではない。

この拒絶理由通知に関するお問い合わせがございましたら下記までご連絡下さい。

特許審査第三部 医療 岩下直人

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## NOTICE OF REASONS FOR REJECTION

Application Number: 2004-071608  
Drafted: 2005/05/27 (year/month/day)  
Examiner: Naoto IWASHITA 9841 4C00  
Attorney: Masatake SHIGA et al.  
Cited Articles: Article 29, Paragraph 2

This application should be rejected for the reason(s) given below. If the applicant wishes to comment thereon, the applicant is invited to submit a response within three months from the Mailing Date of this notice.

### REASON

The invention(s) according to the below-listed claim(s) of the present application could have been easily made prior to the filing of the present application by a person with average knowledge in the field to which the invention(s) belongs based on the invention(s) described in the below-listed distributed publication(s) or made available to the public through electric telecommunication lines in Japan or elsewhere prior to the filing of the present application, and it is therefore deemed to be unpatentable under the provisions of Japanese Patent Law, Article 29, Paragraph 2.

(See A for the cited publications)

### EXAMINER'S COMMENTS

A

- ✓A1. Japanese Unexamined Patent Application, First Publication No. S61-218512
- ✓[A1'. *United States Patent No. 4,661,115; Corresponding English language application*]
- ✓A2. Japanese Unexamined Patent Application, First Publication No. S58-034857
- ✓[A2'. *United Kingdom Patent Application, Publication No. GB 2 104 922 A; Corresponding English language application*]
- ✓A3. Japanese Unexamined Patent Application, First Publication No. S49-050144  
*No English version available*
- ✓A4. Japanese Unexamined Patent Application, First Publication No. H04-120013
- ✓[A4'. *European Patent Application, Publication No. 0 441 263 A1; Corresponding English*

*language application]*

✓A5. PCT International Publication No. WO 01/78668

✓[A5'. *United States Patent Application, Publication No. US 2004/0060125 A1;*

*Corresponding English language application]*

Claims 1 to 28

Citations A1 to A5

Remarks

Considering that, as disclosed in Citations A2 to A5, it is well known that compounds having a pyridine skeleton and which are used as couplers for hair dying agents have an amino radical in position 3 and position 5, it would have been easy for a person skilled in the art to put an amino radical in position 3 and position 5 in a compound like that disclosed in Citation 1, which is a compound having a pyridine skeleton and is used as a coupler for a hair dying agent.

Therefore, it cannot be understood that a significantly remarkable effect exceeding the expectations of a person skilled in the art is achieved by the inventions according to the claims.

## RECORD OF PRIOR ART SEARCH

Searched Technical Fields: IPC 7th Version A61K7/00

DB Name:

Prior Art Reference(s):

This record of the prior art search does not constitute the reasons for rejection.